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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/046,294 | 01/16/2002 | Brian Graham Taylor | 12359 | 2323 |
| 7590 | 03/23/2005 | | EXAMINER | |
| Richard S. Wesorick Tarolli, Sundheim, Cowell, Tummino, L.L.P. 526 Superior Avenue Suite 1111 Cleveland, OH 44114-1400 | | | BOCHNA, DAVID | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3679 | |
| DATE MAILED: 03/23/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|--|-----------------------------|----------------------|
| <i>✓</i> Office Action Summary | Application No. | Applicant(s) |
| | 10/046,294 | TAYLOR, BRIAN GRAHAM |
| | Examiner David E. Bochna | Art Unit 3679 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 February 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,8,10-17,19-22,25-29 and 31-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,8,10-17,19-22,25-29,31,32,35-39 and 41-45 is/are rejected.
- 7) Claim(s) 33-34,40 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 16 January 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims 18, 30 and 31 are withdrawn in view of the newly discovered reference(s) to Thurston et al. Rejections based on the newly cited reference(s) follow.
2. Claim 39 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
3. Claims 33, 34 and 40 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
4. Claim 45 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the subject matter of claim 34 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure

must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 39 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 39 and 45, it is unclear how the 1st and 2nd axially extending portions can be both mutually parallel and also have a seal formed from differential angles tapers on the axially extending portions.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 8, 10-17, 19-22, 31-32, 35-38, 41-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Thurston et al.

In regard to claims 1 and 43, Thurston et al. discloses a riser connector ("for connecting First and second tubulars of an offshore riser for transporting fluids between a well-head at the sea-bed and the surface" is intended use language and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963)); the connector comprising a first portion on the first tubular 2, the first portion having first 26 and second 6 axially extending portions and a threaded portion 22 positioned therebetween, the first axially extending portion 26 being located between the threaded portion and the terminus of the first tubular; and a second portion on the second tubular 30, the second portion having first 31 and second 35 axially extending portions and a threaded portion 21 positioned therebetween, the first axially 31 extending portion being located between the threaded portion 21 and the terminus 11 of the second tubular;

wherein the second axially extending portion 6 of the first portion and the first axially extending portion 31 of the second portion are greater in length than the first axially extending portion 26 of the first portion and the second axially extending portion 35 of the second portion; and wherein, in the assembled connector are mutually parallel, and the second axially extending

portion of the first portion engages the first axially extending portion of the second portion (see fig. 3)

In regard to claim 8, a spigot 26, 31 and a socket 6, 35 comprise the axially extending portions on each tubular.

In regard to claim 10, the spigot 26 on the first tubular engages the socket 35 on the second tubular.

In regard to claim 11, the spigot 31 on the second tubular engages the socket 35 on the first tubular.

In regard to claim 12, the first tubular 2 comprises a pin connector.

In regard to claim 13, the second tubular 30 comprises a box connector.

In regard to claim 14, the socket 6 of the first tubular and spigot 31 on the second tubular are greater in length than the socket 35 of the second tubular and spigot 26 of the first tubular.

In regard to claim 15, the axially extending portions are parallel to the axis of the tubulars.

In regard to claim 16, the first and second tubulars have a tapered profile 4, 39.

In regard to claim 17, the tapered portions of the first and second tubulars are the threaded portions 4, 39 of the first and second tubulars and have co-operating tapers to facilitate mating of the two portions.

In regard to claim 19, the first and second portions have mutually engaging threaded portions 4, 39.

In regard to claim 20, the axially extending portions 6, 26, 31, 35 are unthreaded.

In regard to claim 21, the axially extending portions are load-bearing and allow the transfer of loads between the tubulars.

In regard to claim 22, the axially extending portions allow the transfer of bending loads between the tubulars.

In regard to claims 31, 42 and 44, the first axially extending portion of the first portion engages the second axially extending portion of the second portion (see fig. 3)

In regard to claim 32, wherein, during assembly of the connector, the second axially extending portion 6 of the first portion and the first axially extending portion 31 of the second portion are engaged before the first axially extending portion 26 of the first portion and the second axially extending portion 35 of the second portion are engaged.

In regard to claim 35, further comprising at least one seal 37.

In regard to claim 36, wherein two seals are provided 37, 14.

In regard to claim 37, wherein a first seal 37 is adapted to prevent fluid being released from inside the connector to the threaded and axially extending portions of the connector.

In regard to claim 38, wherein a second seal 14 is adapted to prevent ingress of fluid from outside the connector to the threaded and axially extending portions of the connector.

In regard to claim 41 Thurston et al. discloses a method for connecting a first tubular to a second tubular in a riser for transporting fluids between a well-head at the sea-bed and the surface, the connection being achieved via a riser connector comprising;

a first portion on the first tubular, said first portion having first and second axially extending portions and a threaded portion positioned therebetween,

the first axially extending portion being located between the threaded portion and the terminus of the first tubular; and

a second portion on the second tubular, said second portion having first and second axially extending portions and a threaded portion positioned therebetween, the first axially extending portion being located between the threaded portion and the terminus of the second tubular;

wherein the second axially extending portion of the first portion and the first axially extending portion of the second portion are greater in length than the first axially extending portion of the first portion and the second axially extending portion of the second portion;

and wherein, in the assembled connector, the first axially extending portion of the first portion is axially aligned with the second axially extending portion of the second portion, and the second axially extending portion of the first portion is axially aligned with the first axially extending portion of the second portion, and the first and second axially extending portions of the first and second portions are mutually parallel, and the first axially extending portion of the first portion engages the second axially extending portion of the second portion;

said method comprising the steps of:

gripping the second tubular at a position spaced from its terminus';

engaging the first and second tubulars;

gripping the first tubular', and

applying torque between the tubulars.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thurston et al. '212. Thurston et al. discloses a riser connector as described above, but does not specifically disclose the exact lengths recited in the present invention. However, it would have been obvious to a person having ordinary skill in the art to make the lengths that of those recited in claims 25-29 because a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Response to Arguments

12. Applicant's arguments filed on 2/24/05 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Bochna whose telephone number is (703) 306-9040. The examiner can normally be reached on 8-5:30 Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 3679

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.



**David Bochna
Primary Examiner
Art Unit 3679
March 10, 2005**